

REMARKSParagraphs 1-9 of the Office Action

5       Claims 1, 2, 5-7, 9 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Elias in view of Warner.

Applicant's device includes a lip which is perpendicular to the peripheral wall for retaining the device on a penis when it is flaccid. Applicant's device also includes a continuous band that has a rectangular cross-section to prevent the rolling up of the device.

10      Warner is cited by the Examiner for the finding of a lip. It is respectfully submitted that the Warner describes a bead at column 2, line 1. A bead, by definition, has a circular shape. Because of this, the bead cannot be a lip that is orientated perpendicular to the peripheral wall. For this reason, the element of a lip orientated perpendicular to the peripheral wall is not found in the prior art and therefore it is  
15      believed that amended claims 1 and 9, and all remaining claims depending from claim 1, are in condition for allowance.

As to Elias, it is cited for the showing of a band. However, it is respectfully submitted to the Examiner that Elias does not include a band but a "flap 10 (that) is discontinuous with respect to distal end portion 6...." Column 3, lines 18-19. The flap  
20      is attachable to an extension 8 by an adhesive layer 16. The flap is susceptible to mechanical failure. This disadvantage is increased by the use of the adhesive which may break down by perspiration and heat from the body. Additionally, if Elias is also being cited for the teaching of bands in general, there is still no teaching of a band having a rectangular cross-section. As previously stated, the bands of the prior art are typically  
25      bulbous end portions, which are rounded and therefore will have a tendency to cause the device to roll up. Since this element is missing from the prior art, it is again believed that the remaining claims are in condition for allowance.

Alternatively, there must still be found a motivation to combine Warner and Elias.  
As the Examiner points out in the office action, Elias teaches against a band. If Elias  
30      teaches against bands, how can there be motivation to make a combination having the

elements of Elias and Warner and a band as shown in applicant's device? If there is no motivation found within the prior art, the combination cannot be found to be obvious.

5       'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

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In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)). Here, not only did Elias not teach the desirability but actually taught against the use of a band. The Examiner has argued that Elias shows a band while at the same time admitting Elias teaches against a band. Obviousness cannot be found in such an argument and it is therefore believed that the remaining claims in allowable form.

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20       The applicant respectfully requests withdrawal of the rejection.

#### Making the Office Action Final

The Examiner has made this action final, however it is believed that such a designation is erroneous. The Examiner has made a new argument by the inclusion of Warner. However, claim 9 had not been amended on the first office action. The  
25       Examiner has not afforded applicant an opportunity to make arguments with respect to a new citation that relates to the original claim. For this reason, applicant should have been awarded a second office action and applicant requests that if a notice of allowance is not issued after the review of this reply, that applicant be afforded an additional three months for another reply.

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**CONCLUSION**

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In light of the foregoing amendments and remarks, early consideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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